

Appl. No.: 09/827,352  
Reply to Office Action of January 24, 2005

PATENT

### Remark

The Applicant respectfully requests reconsideration of this application as amended. In this amendment, Applicant has amended claims 1 and 19. No claims have been cancelled. Hence, claims 1 – 23 are pending in this application after the filing of this amendment.

### Claim Rejections

In the Office action, claims 1 – 7, 10 – 16, and 19 – 23 were rejected under 35 U.S.C. 103(a) as purportedly being unpatentable over EP1014633 to Bennefeld in view of U.S. Patent No. 4,991,204 to Yamamoto. Claims 8, 9, 17, and 18 were rejected under 35 U.S.C. 103(a) as purportedly be unpatentable over Bennefeld in view of Yamamoto and in further view of U.S. Patent No. 5,956,339 to Harada.

### General Discussion

Prior to discussing each rejection in detail, each of the cited references is discussed generally.

Bennefeld relates to a method and apparatus for distributing subscriber load among a plurality of gatekeepers of an Internet protocol telephony communication system by selectively assigning subscriber load to the plurality of gatekeepers *during the discovery and registration process*. Bennefeld, [0001]. As such, Bennefeld focuses on gatekeeper registration as the way of managing subscriber loading. *id.* at [0030], [0031].

Yamamoto was filed in 1989 and relates to adaptive routing of calls through a circuit-switched network. Yamamoto, Abstract; col. 1, ll. 32 – 36. Yamamoto is concerned with choosing a route through circuit switches if trunks between switching nodes on the route are idle. *id.* at col. 7, ll. 27 – 45.

Harada relates to an apparatus for routing individual packets from a sending node to a receiving node. Harada, Abstract; col. 3, ll. 23 – 26; col. 7, ll. 9 – 14. For each packet, the Harada apparatus calculates total channel capacity of each route and inter-node uniformity to choose a route for the packet. *id.* at Abstract.

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**Claim Rejections – 35 U.S.C. § 103**

**Claims 1 – 7, 10 – 16, and 19 – 23**

Claims 1 – 7, 10 – 16, and 19 – 23 were rejected over Bennefeld in view of Yamamoto. Applicant traverses these rejections for the following reasons.

**No Motivation to combine Bennefeld and Yamamoto**

The Office asserts that Bennefeld can be changed using teachings of Yamamoto. The proposed modification cannot change the principle of operation of a reference. MPEP, 2143.01. Bennefeld's principle of operation is to equalize subscriber loading by registering subscribers with gatekeepers in a distributed fashion. Bennefeld at [0030]. The Office's suggestion that Bennefeld could be changed to use alternate routing using a list of routes, rather than gatekeeper registration, in order to distribute subscriber load, would clearly change Bennefeld's principle of operation.

In addition, the Office's proposed modification or combination cannot render the prior art unsatisfactory for its intended purpose. MPEP, 2143.01. The Office asserts that Yamamoto's routing tables could be used in Bennefeld to satisfy call routing. Bennefeld's intended purpose is to distribute subscriber load by registering subscribers with gatekeepers. However, Yamamoto indicates that an alternate route is selected randomly, cyclically, or on a predetermined order basis. Yamamoto, col. 8, ll. 42 – 54. Thus, if Bennefeld were to be changed to use Yamamoto's routing tables, Bennefeld would be rendered unsatisfactory for its intended purpose; i.e., Bennefeld would not distribute subscriber load through gatekeeper registration.

Even if Bennefeld could be modified as proposed by the Office, the mere fact that references can be combined or modified is not sufficient to establish prima facie obviousness, unless prior art also suggests the desirability of the combination. MPEP, 2143.01. The teaching or suggestion and reasonable expectation of success of the claimed combination must both be found in the prior art, not in applicant's disclosure. *id.* at 2143.

In this case, the Office appears to have found the suggestion for combination and reasonable expectation of success in the Applicant's disclosure and not in the prior art. As discussed above, Bennefeld is directed to load balancing by registration of gatekeepers in an Internet Telephony network. Bennefeld, Abstract. However, Yamamoto is obviously directed toward circuit-switched networks. (see, e.g., col. 1, ll. 32 – 37 (referencing "A Survey of

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Dynamic Routing Methods for Circuit Switched Traffic" to show the two classes of routing), and col. 5, ll. 19 – 33 ("...switching nodes N1 to N6 are connected to the network control center NC...possess the functions of an originating node which originates a call, a transit node which relays the call, and a terminating node which is the destination of the call). Indeed, Yamamoto was filed in 1989, years before the beginnings of Internet Protocol telephony.

As such, there is clearly no motivation or suggestion to combine Bennefeld with Yamamoto. Indeed, the references themselves teach away from such a combination.

**Even if combined, Bennefeld and Yamamoto neither teach nor suggest all elements of claims 1 – 7, 10 – 16, or 19 – 23**

To support its case of obviousness, the Office must show, among other things, that the prior art references teach or suggest all the claim limitations. MPEP, 2142. All words in a claim must be considered in judging the patentability of that claim. MPEP, 2143.03.

The Office asserts that Bennefeld's Internet Protocol telephony system does not include storing route lists in memory and selecting alternate routes based on the request, but the Office asserts that Yamamoto can make up for Bennefeld's shortcomings. However, as discussed above, Yamamoto is directed to circuit-switched networks and does not contemplate Internet Telephony.

Claim 1 as amended recites, in part, "...wherein each route is associated with one of the plurality of resource management gatekeepers; and...selecting a route from the list of routes using the corresponding resource management gatekeeper to determine resource availability." Thus, in claim 1, routes are associated with gatekeepers that are used to determine resource availability.

By contrast, Yamamoto's routes are associated with circuit-switching nodes (e.g., N1 – N6), such as originating node, transit node, and terminating node. Yamamoto, col. 7, ll. 14 – 36. As such, Yamamoto's routes do not pertain to gatekeepers, as is recited in claim 1.

In addition, Bennefeld, even if combined with Yamamoto, does not teach selecting a route from the list of routes using the corresponding resource management gatekeeper to determine resource availability. The Office apparently asserts that Bennefeld's registration load management unit (RLMU) is a resource as recited in claim 1. Even if this were true, Bennefeld discusses gatekeeper availability for registration. Bennefeld, [0031]. Applicant can

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find no teaching or reasonable suggestion in Bennefeld of selecting a route ... to determine RLMU availability.

For at least the foregoing reasons, the combination of Bennefeld and Yamamoto fail to teach or reasonably suggest all the limitations of claim 1. For at least these same reasons, Bennefeld and Yamamoto fail to teach or suggest all the limitations of claims 10 and 19.

Claims 2 – 7 each depend from claim 1 in some manner. Therefore, claims 2 – 7 include all the limitations of claim 1 and are considered allowable over Bennefeld and Yamamoto for at least the reasons given above. Similarly, claims 11 – 16 depend from claim 10 and claims 20 – 23 depend from claim 19. As such, claims 11 – 16 and 20 – 23 are considered allowable for at least the reasons given above.

### **Claim Rejections – 35 U.S.C. § 103**

#### **Claims 8, 9, 17, and 18**

Claims 8, 9, 17, and 18 were rejected over Bennefeld in view of Yamamoto, and in further view of Harada. Applicant traverses these rejections for the following reasons.

#### **No Motivation to combine Harada and Yamamoto**

The Office asserts that Yamamoto can be changed or combined with Harada. However, the proposed modification would change the principle of operation of Yamamoto and/or Harada. MPEP, 2143.01. As discussed above, Yamamoto discloses a system for routing calls in a circuit-switched network. By contrast, Harada discloses an apparatus for routing packets from a sending node to a receiving node. (see e.g., Harada, col. 7, ll. 56 – 67). Clearly, Yamamoto's routing scheme in a circuit-switched network cannot be changed/combined with Harada's packet-based system without changing the principle of operation of Yamamoto.

As such, there is clearly no motivation or suggestion to combine Harada with Yamamoto. Indeed, Harada and Yamamoto teach away from such a combination.

#### **No Motivation to combine Bennefeld and Harada**

The Office asserts that Bennefeld can be changed or combined with Harada. However, the proposed modification would change the principle of operation of Bennefeld. MPEP, 2143.01. As discussed above, Bennefeld discloses a system for distributing subscriber load by a gatekeeper registration process. By contrast, Harada discloses an apparatus for routing

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individual packets from a sending node to a receiving node based on channel capacity. (see e.g., Harada, col. 7, ll. 56 – 67). In Harada, a change in channel capacity occurs when signaling links are added or removed, channel or equipment fails/shuts down, or an update request message is received. id. at col. 8, ll. 36 – 41. The routing in Harada is based on different criteria than the system in Bennefeld, and, as such, Harada's routing could be contradictory to the subscriber registration of Bennefeld. Clearly, Bennefeld's gatekeeper registration scheme cannot be changed/combined with Harada's packet-routing system without changing the principle of operation of Bennefeld.

As such, there is clearly no motivation or suggestion to combine Harada with Bennefeld. Indeed, Harada and Bennefeld teach away from such a combination.

**Even if combined, Bennefeld, Yamamoto and Harada do not teach or suggest all elements of claims 8, 9, 17, or 18**

Claims 8 and 9 depend from claim 1 and therefore inherit all the limitations of claim 1. Therefore, claims 8 and 9 are believed to be allowable over Bennefeld, Yamamoto, and Harada for at least the reasons given above with respect to claim 1. Similarly, claims 17 and 18 depend from claim 10 and are believed to be allowable for the reasons given for claim 10 above.

With specific regard to claims 9 and 18, the Office states that all the routes in Bennefeld have a substantially equal likelihood of being chosen because they are either chosen or not. The Office has not provided any evidence from Bennefeld supporting this assertion. Indeed, Bennefeld does not teach candidate route selection. As discussed above, Bennefeld distributes subscriber loading through the process of gatekeeper discovery and registration. Bennefeld at [0010]. Applicant can find no teaching in Bennefeld as to the particular method of routing calls. As such, the ratio of candidate route selection is not addressed in Bennefeld. Therefore, the Office has not met its burden of a prima facie case of unpatentability of claims 9 and 18.

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**Conclusion**

Applicant respectfully submits that the foregoing remarks have addressed all the issues raised in the Office action, have overcome the rejections, and that the pending claims are in condition for allowance. Accordingly, Applicant requests that the rejections be withdrawn and that a Notice of Allowance be issued forthwith.

**Request for a Telephone Interview**

If the Office believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-447-7739.

Respectfully submitted,



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